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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,882	09/28/2001	John S. Hendricks	3960.D16	2107
38598	7590	03/22/2005	EXAMINER	
ANDREWS KURTH L.L.P. 1701 PENNSYLVANIA AVENUE, N.W. SUITE 300 WASHINGTON, DC 20006			TESLOVICH, TAMARA	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	09/964,882	HENDRICKS, JOHN S.
	Examiner Tamara Teslovich	Art Unit 2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 September 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 December 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20 August 02</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This action is in response to Preliminary Amendments filed on September 28,
5 2001.

Claims 1-9 have been cancelled.

Claims 10-31 are pending.
10

Objections - Specification

The disclosure is objected to because of the following informalities:

Applicant's 'Marked-Up Copy of Specification Amendments' cites US Patent Application 08/160,194 but provides an incorrect filing date, the correct date being
15 December 2, 1993, not December 9, 1993. Applicant also fails to provide the US Patent Number associated with said application, US Patent No. 5,990,927. Appropriate correction is required.

Claim Rejections - 35 USC § 112

20 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being
25 indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second

paragraph (see *Ex parte Lyell*, 17 USPQ2d 1548, Board of Patent Appeals and Interferences 1990).

Claim Rejections - 35 USC § 101

5 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10 Claims 21-31 are rejected under 35 U.S.C. 101 based on the theory that the claims are directed to neither “processes” nor “machines”; but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of inventions in the alternative *only*.

15 ***Claim Rejections - 35 USC § 103***
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25 Claims 13-15, 20, 24-26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US Patent 4,855,725) and further in view of Seth-Smith et al (US Patent 4,829,569).

As per Claim 13, Fernandez teaches a method for restricting access to electronic books displayed on a viewer, comprising:

storing an electronic book on a viewer (see Fernandez col.3 lines 18-21; col.9 lines 21-24);

5 associating a unique code number with the electronic book (see Fernandez col.9 lines 29-32);

restricting access to the electronic book to the unique viewer for display on the unique viewer (see Fernandez col.9 lines 25-42).

10 Fernandez fails to teach associating the unique code number of the electronic book with a unique viewer.

Seth-Smith teaches associating electronic books with a unique viewer wherein only specific viewers [decoders] are enabled to receive and decrypt specific electronic books [specific messages] (see Seth-Smith col.3 lines 14-28).

15 It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Fernandez restricting access to electronic books for certain unique viewers as described in Seth-Smith to ensure that information meant for a specified user cannot be intercepted and read by anyone but the intended viewer.

20 As per Claim 14, the combined system of Fernandez and Seth-Smith teaches the method of Claim 13, further including displaying a menu providing an identification of the electronic book for selection [the whole system is to be menudriven] (see Seth-Smith col.5 lines 60-63; col.12 lines 52-57).

As per Claim 15, the combined system of Fernandez and Seth-Smith teaches the method of Claim 14, wherein the restricting step includes:

- receiving an identification of the viewer [a secret serial number stored in the
5 EEPROM];
determining if the identification of the viewer corresponds with the unique viewer
[the correlation between the decoder identification and the secret serial number stored
in the EEPROM is critical to the proper functioning of this system] (see Seth-Smith
col.19 lines 38-63).

10

As per Claim 20, Fernandez teaches a method for restricting access to electronic books displayed on a viewer, comprising:

storing an electronic book on a viewer for viewing at a later time (see Fernandez
col.3 lines 18-21; col.9 lines 21-24).

15 Fernandez fails to teach storing an identification of a viewer unique key,
encrypting the stored electronic book based upon the viewer unique key, and decrypting
the electronic book only upon receipt of the viewer unique key

Seth-Smith teaches storing an identification of a viewer unique key, encrypting
the stored electronic book based upon the viewer unique key, and decrypting the
20 electronic book only upon receipt of the viewer unique key (see Seth-Smith col.19 lines
38-63; col.24 lines 25-27).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Fernandez the additional access specifications relating to viewer unique keys as described in Seth-Smith to ensure that information meant for a specified user cannot be intercepted and read by anyone but the intended viewer.

5

As per Claim 24, Fernandez teaches a viewer for displaying electronic books, comprising:

a portable viewer having a processor, a memory for storing instruction, a memory for storing electronic books, and a display for displaying the electronic books (see 10 Fernandez col.2 lines 43-63), wherein the processor operated under control of the instructions to execute a method comprising :

storing an electronic book on a viewer (see Fernandez col.3 lines 18-21; col.9 lines 21-24);

associating a unique code number with the electronic book (see Fernandez col.9 15 lines 29-32);

restricting access to the electronic book to the unique viewer for display on the unique viewer (see Fernandez col.9 lines 25-42).

Fernandez fails to teach associating the unique code number of the electronic book with a unique viewer.

20 Seth-Smith teaches associating electronic books with a unique viewer wherein only specific viewers [decoders] are enabled to receive and decrypt specific electronic books [specific messages] (see Seth-Smith col.3 lines 14-28).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Fernandez restricting access to electronic books for certain unique viewers as described in Seth-Smith to ensure that information meant for a specified user cannot be intercepted and read by anyone but the intended viewer.

5

As per Claim 25, the combined system of Fernandez and Seth-Smith teaches the viewer of Claim 24, further including displaying a menu providing an identification of the electronic book for selection [the whole system is to be menu driven] (see Seth-Smith col.5 lines 60-63; col.12 lines 52-57).

10

As per Claim 26, the combined system of Fernandez and Seth-Smith teaches the method of Claim 25, wherein the restricting step includes:

receiving an identification of the viewer [a secret serial number stored in the EEPROM];

15 determining if the identification of the viewer corresponds with the unique viewer [the correlation between the decoder identification and the secret serial number stored in the EEPROM is critical to the proper functioning of this system] (see Seth-Smith col.19 lines 38-63).

20 As per Claim 31, Fernandez teaches a viewer for displaying electronic books, comprising:

a portable viewer having a processor, a memory for storing instruction, a memory for storing electronic books, and a display for displaying the electronic books (see Fernandez col.2 lines 43-63), wherein the processor operated under control of the instructions to execute a method comprising:

- 5 storing an electronic book on a viewer for viewing at a later time (see Fernandez col.3 lines 18-21; col.9 lines 21-24).

Fernandez fails to specifically mention storing an identification of a viewer unique key, encrypting the stored electronic book based upon the viewer unique key, and decrypting the electronic book only upon receipt of the viewer unique key

- 10 Seth-Smith teaches storing an identification of a viewer unique key, encrypting the stored electronic book based upon the viewer unique key, and decrypting the electronic book only upon receipt of the viewer unique key (see Seth-Smith col.19 lines 38-63; col.24 lines 25-27).

- 15 It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Fernandez the additional access specifications relating to viewer unique keys as described in Seth-Smith to ensure that information meant for one user cannot be intercepted and read by anyone but the intended viewer.

- 20 Claims 10-12, 16-19, 21-23 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez (US Patent 4,855,725) and further in view of Seth-Smith et al (US Patent 4,829,569) and Kudelski et al. (US Patent 5,144,663).

As per Claim 10, Fernandez teaches a method for restricting access to electronic books displayed on a viewer comprising:

storing an electronic book on a viewer [according to encoding and decoding protocols well known in the art] (see Fernandez col.4 lines 20-25), the electronic book

5 having a plurality of pages (see Fernandez col.3 lines 18-21; col.9 lines 21-24);

receiving a request to view the electronic book (see Fernandez col.4 lines 36-37);

and

viewing the pages on a page-by-page basis (see Fernandez col.4 lines 63-67).

Fernandez fails to teach the storing of the electronic book in an 'encrypted' form,

10 the decryption of pages one at a time for viewing and the re-encrypting of pages no longer on display.

Seth-Smith teaches the storing of encrypted teletext [electronic book] received by a decoder [viewer] as part of a data communication system, wherein teletext is stored, decrypted and displayed a page at a time when requested (see Seth-Smith col.col.3

15 lines 23-28; col.18 lines 11-18; col.20 lines 64-68).

Kudelski teaches the method of interactive communication between the subscriber and decoder in a Seth-Smith Subscription Television System, further describing the liberation of segments of memory pertaining to decrypted pages with the selection of a new page for viewing so that pages not currently in view are securely

20 stored in an encrypted form, not in plaintext (see Kudelski col4. lines 19-46).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Seth-Smith the liberation method as described in Kudelski to provide safety against piracy by securing teletext [electronic books] when not in use.

5 As per Claim 11, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the method of Claim 10 wherein the decrypting the pages includes decrypting the pages on a page-by-page basis upon receiving a unique key associated with the electronic book (see Fernandez col. 10 lines 5-14; see Seth-Smith col.3 lines 23-28; col.10 lines 39-42; col.19 lines 38-63).

10 As per Claim 12, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the method of Claim 10 wherein receiving step includes displaying a menu providing an identification of the electronic book for selection [the whole system is to be menudriven] (see Seth-Smith col.5 lines 60-63; col.12 lines 52-57).

15 As per Claim 16, Fernandez teaches a method for restricting access to electronic books displayed on a viewer, comprising:

 storing an electronic book on a viewer for viewing at a later time (see Fernandez col.3 lines 18-21; col.9 lines 21-24);

20 Fernandez fails to specifically mention associating a time parameter with the electronic book and restricting access to the electronic book, for display on the electronic book on the viewer, based upon the time parameter.

Seth-Smith teaches the association of specific time parameters [the individual decoders use the tier number transmitted as part of the system data to either enable or disable the viewing of a particular program at a particular time] (see Seth-Smith col.10 lines 55-58)

- 5 Kudelski teaches the association of specific time parameters with the electronic data (see Kudelski col.6 lines 46-50; col.7 line 65 thru col.8 line 9).

- It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Fernandez the additional access specifications relating to time parameters as described in Seth-Smith and Kudelski to ensure the close control of 10 dissemination of information only when appropriate.

- As per Claim 17, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the method of Claim 16, include deleting the electronic book from the viewer based on the time parameter [date of expiration] (see Kudelski col.6 lines 46-50; col.7 15 line 65 thru col.8 line 9).

- As per Claim 18, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the method of Claim 17, wherein the deleting step includes automatically erasing the electronic book from the view upon expiration of a particular time period 20 [date of expiration] (see Kudelski col.6 lines 46-50; col.7 line 65 thru col.8 line 9).

As per Claim 19, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the method of Claim 16, wherein the restricting step includes providing permanent storage of the electronic book on the viewer (see Fernandez col.3 lines 24-35).

5

As per Claim 21, Fernandez teaches a viewer for displaying electronic books, comprising:

a portable viewer having a processor, a memory for storing instruction, a memory for storing electronic books, and a display for displaying the electronic books (see 10 Fernandez col.2 lines 43-63), wherein the processor operated under control of the instructions to execute a method comprising :

storing an electronic book on a viewer [according to encoding and decoding protocols well known in the art] (see Fernandez col.4 lines 20-25), the electronic book having a plurality of pages (see Fernandez col.3 lines 18-21; col.9 lines 21-24);

15 receiving a request to view the electronic book (see Fernandez col.4 lines 36-37); and

viewing the pages on a page-by-page basis (see Fernandez col.4 lines 63-67).

Fernandez fails to teach the storing of the electronic book in an 'encrypted' form, the decryption of pages one at a time for viewing and the re-encrypting of pages no 20 longer on display.

Seth-Smith teaches the storing of encrypted teletext [electronic book] received by a decoder [viewer] as part of a data communication system, wherein teletext is stored,

decrypted and displayed a page at a time when requested (see Seth-Smith col.col.3 lines 23-28; col.18 lines 11-18; col.20 lines 64-68).

Kudelski teaches the method of interactive communication between the subscriber and decoder in a Seth-Smith Subscription Television System, further 5 describing the liberation of segments of memory pertaining to decrypted pages with the selection of a new page for viewing (see Kudelski col4. lines 19-46).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Seth-Smith the liberation method as described in Kudelski to provide safety against piracy by securing teletext [electronic books] when not in use.

10

As per Claim 22, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the viewer of Claim 21 wherein the decrypting the pages includes decrypting the pages on a page-by-page basis upon receiving a unique key associated with the electronic book (see Fernandez col. 10 lines 5-14; see Seth-Smith col.3 lines 23-28; 15 col.10 lines 39-42; col.19 lines 38-63).

As per Claim 23, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the viewer of Claim 21 wherein receiving step includes displaying a menu providing an identification of the electronic book for selection [the whole system is to be 20 menudriven] (see Seth-Smith col.5 lines 60-63; col.12 lines 52-57).

As per Claim 27, Fernandez teaches a viewer for displaying electronic books, comprising:

a portable viewer having a processor, a memory for storing instruction, a memory for storing electronic books, and a display for displaying the electronic books (see

- 5 Fernandez col.2 lines 43-63), wherein the processor operated under control of the instructions to execute a method comprising:

storing an electronic book on a viewer for viewing at a later time (see Fernandez col.3 lines 18-21; col.9 lines 21-24);

Fernandez fails to teach associating a time parameter with the electronic book

- 10 and restricting access to the electronic book, for display on the electronic book on the viewer, based upon the time parameter.

Seth-Smith teaches the association of specific time parameters [the individual decoders use the tier number transmitted as part of the system data to either enable or disable the viewing of a particular program at a particular time] (see Seth-Smith col.10
15 lines 55-58)

Kudelski teaches the association of specific time parameters with the electronic data (see Kudelski col.6 lines 46-50; col.7 line 65 thru col.8 line 9).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include within Fernandez the additional access specifications relating to
20 time parameters as described in Seth-Smith and Kudelski to ensure the close control of dissemination of information only when appropriate.

As per Claim 28, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the viewer of Claim 27, including deleting the electronic book from the viewer based on the time parameter [date of expiration] (see Kudelski col.6 lines 46-50; col.7 line 65 thru col.8 line 9).

5

As per Claim 29, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the viewer of Claim 28, wherein the deleting step includes automatically erasing the electronic book from the view upon expiration of a particular time period [date of expiration] (see Kudelski col.6 lines 46-50; col.7 line 65 thru col.8 line 9).

10

As per Claim 30, the combined system of Fernandez, Seth-Smith, and Kudelski teaches the viewer of Claim 27, wherein the restricting step includes providing permanent storage of the electronic book on the viewer (see Fernandez col.3 lines 24-35).

15

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for 5 published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10



Tamara Teslovich
15 March 15, 2005



ANDREW CALDWELL
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